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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,929	04/02/1999	CHARLES MCELFRESH	22499-701	4307

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EXAMINER	
HONG, STEPHEN S	

ART UNIT	PAPER NUMBER
2178	20

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/285,929	MCELFRESH ET AL.	
	Examiner	Art Unit	
	Stephen S. Hong	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/29/03* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-73* is/are pending in the application.

4a) Of the above claim(s) *9-18, 27-35, 51-73* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 19-26 and 36-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *16* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to communications: election filed on September 29, 2003 to the application, filed on April 2, 1999; prior art, filed on 7/30/02 and 8/8/02.

2. Claims 1-73 are pending in the case. Elected claims 1-8, 19-26 and 36-50 are addressed on merits in this office action.

Election/Restriction

3. Applicant's election of Invention I, Claims 1-8, 19-26 and 36-50 in Paper No. 19 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a))

Specification

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-8, 19-26 and 36-50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz et al., U.S. Pat. No. 6,311,185 B1, 10/01 in view of Cannon, U.S. Pat. No. 6,286,005 B1, 9/01 and in view of the Applicant's admitted well known prior art, on page 1-3 of the specification.

As per claims 1-8, 19-26 and 36-50, Markowitz discloses the following claimed features:

storing and retrieving performance data associated with the likelihood of the event occurring for each object and prioritizing the objects on the page according to the performance data (col.3, line 2, "A history database 210 can be consulted...when selecting the advertisement"); and the performance data includes the user's characteristics and profiles (col.3, lines 1-17, "...the user's age, sex and hobbies...demographic database...")).; Although Markowitz does not explicitly disclose the pay-per-click type of advertisement payment by the advertisers, as Applicant points out (on page 2 of the specification) such was extremely well known practice in the WWW advertisement, and thus would have been obvious to a person of ordinary skill in the art at the time of the invention.

Furthermore, Markowitz teaches the rearrangement of the advertisements on the page to provide an effective advertisement (col.4, line 20-45, "...advertisements.. could be positioned above and below the text.."). However, Markowitz does not explicitly point out that the rearrangement of the advertisement is based on the user statistics and/or profiles. Nevertheless, this feature is taught by the prior art of Cannon. Cannon teaches the system for optimally producing computer-based advertisements. In the prior art, Cannon teaches that the "positioning of advertisements and promotion in a

media environment ...is integrated in the sense that it considers a comprehensive set of factors identifying optimal plans...including service usage, reach, frequency, learning, timing, demographics, viewer response and cost. (col.30, line 66 to col.31, line 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Cannon's teaching into Markowitz to position the advertisement based on the user-based profiles, since Cannon explicitly pointed out the effectiveness of such advertisement placement.

Response to Arguments

7. Applicant's arguments filed 4/11/03 have been fully considered but they are not persuasive.

On page 4 of the amendment, Applicant asserts that "Markowitz does not describe or suggest arranging objects on a page according to stored performance data for the respective objects, as recited for example in Applicant's claim 1." Applicant then contends that "Markowitz does not even recognize the issue of how to arrange multiple advertisement relative to one another on a web page." Examiner disagrees with this analysis of the claimed invention. What is claimed invention in Claim 1 is:

"storing and retrieving performance data associated with the likelihood of the event occurring for each object; and arranging the object on the page according to the performance data."

Note that the claim does not require a particular "performance data" or a particular "likelihood" measurement. That is Markowitz allows the advertisements to be selected based on the likelihood of the advertisement being clicked by the particular user. Since

the selected advertisements are incorporated (i.e., arranged) into the web page, Markowitz teaches the invention at least as claimed.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-final	(703) 746-7238
Official	(703) 746-7239
Non-Official/Draft	(703) 746-7240

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Stephen Hong

Primary Examiner

December 29, 2003